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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,067	08/20/2001	Steve Brandstetter	P/94-1	6703

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EXAMINER	
COBURN, CORBETT B	
ART UNIT	**PAPER NUMBER**
3714	17

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/933,067	BRANDSTETTER ET AL.	
	Examiner	Art Unit	
	Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12-14, 17 & 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Quinn (US Patent Number 3,688,276).

Claim 12: Quinn teaches a game machine (16) that is a slot machine – i.e., it is a machine whose operation is begun by dropping a coin into a slot (48). The player puts in coins. (Col 4, 38-40) The machine counts the coins and the number of counted coins is shown to the player. (Col 4, 47-50) The number of coins needed for a ticket to be generated in shown to the player. (Col 4, 40-41) A ticket is dispensed when the number of counted coins equals the number of coins needed. (Col 2, 6-12) Quinn teaches vending a lottery ticket, thus it is a gambling machine. Lotteries inherently pay off according to matching of symbols.

Claim 13: The counting the coins is accomplished by counting coin pulses off of the machine's hard meter and the ticket is dispensed base on the number of coins deposited. (Col 2, 6-12)

Claim 14: The ticket is a lottery ticket. (Abstract)

Claim 17: The number of counted coins is set to zero once a ticket is dispensed. (Col 4, 47-50)

Claim 18: Quinn teaches using a remote unit to set the price of the ticket. (Col 1, 64 – Col 2, 16)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 3, 4, 6 & 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castellano et al. (US Patent Number 5,477,952) in view of Dabrowski (US Patent Number 5,544,728).

Claims 1: Castellano teaches a game machine (Col 13, 23). There is a counter for counting the number of coins a player has placed in the machine. (Col 6, 32-36) The numeric counter counts all coins placed into the gaming machine – thus it continues to count coins until a ticket is generated. There is a means (the game machine's display) for showing the player when the ticket will be printed (i.e. when the player wins the game). There is a ticket dispenser (31). Castellano teaches that there is a readout for externally communicating the current coin count. (Col 6, 11-13) It is not clear, however, whether this readout is for visually displaying the number of coins to the player. Dabrowski teaches a visual display (126) for displaying the number of credits remaining (corresponding to the number of coins) to the player. This allows the player to see how many coins the player has inserted into the machine and how many are available for gambling. It would have been obvious to one of ordinary skill in the art at the time of the

invention to have a visual display of the number of coins entered in order to allow the player to see how many coins the player has inserted into the machine and how many are available for gambling.

Claim 3: The dispensing unit is placed inside the game machine. (Col 12, 22-28)

Claim 4: The dispensing unit is an add-on to any existing gaming machine and gaming device. (Col 16, 17-20)

Claim 6: The dispensing unit is a self-contained unit that does not affect the play or outcome of the game.

Claim 8: Fig 1 clearly shows four coin slots (21-24) that correspond to different denominations (i.e., nickel, dime, quarter, and dollar).

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Castellano and Dabrowski as applied to claim 1 above, and further in view of Bittner et al. (US Patent Number 5,290,033).

Claim 2: Castellano and Dabrowski teach the invention substantially as claimed. Castellano does not, however, teach mounting the device on the side of the game machine. Bittner teaches mounting an analogous device (202) on the side of the gaming machine. Castellano teaches that the device can be used as a retrofit to existing game machines. In cases where the device did not fit within the game cabinet, it would have been obvious to one of ordinary skill in the art at the time of the invention to have attached the dispensing unit to the gaming machine as a side mounted box in order to retrofit a gaming machine that did not have room inside the gaming machine cabinet.

6. Claims 5 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castellano and Dabrowski as applied to claim 1 above, and further in view of Heidel et al. (US patent Number 5,342,047).

Claim 5: Castellano and Dabrowski teach the invention substantially as claimed. Castellano teaches that the device may be attached to virtually any gaming machine. (Col 16, 17-20) Dabrowski teaches attaching a device to a slot (i.e., gaming) machine. (Abstract) Castellano's invention is intended to detect and prevent fraud. (Abstract) Fraud is a significant problem in the gaming industry. Heidel teaches a game machine that can be used a number of different games. Heidel illustrates video poker (Fig 1) and video keno (Fig 2b). Video bingo is a well-known equivalent. Video poker, keno, and bingo are all extremely well known in the art. They are extremely popular with many players and, along with reel-type machines, form the backbone of the electronic gaming industry. It would have been obvious to one of ordinary skill in the art to have applied Castellano's coin tracker to video poker, keno, and bingo machines in order to detect and prevent fraud.

Claim 9: Castellano and Dabrowski teach the invention substantially as claimed. Castellano teaches printing a ticket as a reward, but does not teach that the ticket is a lottery ticket. Heidel teaches dispensing a lottery ticket. (Col 1, 10-18)

7. Claims 7, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castellano and Dabrowski as applied to claim 1 above, and further in view of Piechowiak et al. (US Patent Number 6,012,982).

Claim 7: Castellano and Dabrowski teach the invention substantially as disclosed. Castellano's Fig 3 shows the counter (12) counting pulses of the game machines hard meter (52). Castellano does not, however, teach awarding the player a bonus based on the number of coins played. Piechowiak teaches a game that awards a bonus based on a player reaching a certain coin-in threshold. (Abstract) Bonuses are well known to the art and are commonly used to increase player interest. It would have been obvious to one of ordinary skill in the art at the time of the invention to have awarded the player a bonus based on the number of coins played in order to increase interest in the game.

Claim 10: Piechowiak teaches linking games so that a combination of devices must have a certain number of coins inserted before a bonus (ticket) is dispensed. (Abstract)

Claim 11: Piechowiak teaches that there is a remote unit (122) for changing the number of coins necessary to generate the ticket.

8. Claims 15 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quinn as applied to claim 12 or 14 in view of the Big Game Lottery.

Claims 15 & 16: Quinn teaches the invention substantially as claimed. Quinn teaches dispensing lottery tickets, but does not go into the mechanics of how lotteries operate. Lotteries operate using well-known principles. The Big Game is merely one of a myriad of examples of lotteries. The winner of lotteries is determined by holding a drawing – i.e., by lot. The size of the lottery jackpot is based on the number of tickets sold. In other words, the bonus prize is based on a percentage of total coins placed into all participating gaming machines. It would have been obvious to one of ordinary skill in the art at the time of the invention to have chosen the winner of the lottery by a random drawing and to

have based the jackpot on a percentage of total coins placed into the gaming machines in order to follow standard practice for running a lottery.

Response to Arguments

9. Applicant's arguments filed 5 December 2003 have been fully considered but they are not persuasive.

10. Applicant argues that Quinn does not anticipate the claimed invention because the player does not play a gaming machine as defined in the amended claims. As pointed out above, this is incorrect. Quinn dispenses lottery tickets – thus Quinn's machine is a gambling machine. When the player purchases a lottery ticket, the player is playing the game – thus playing a gambling machine. Lotteries inherently pay off depending on matching symbols. Quinn meets each and every element of the amended claim. Furthermore, if Applicant had claimed a gaming machine that paid off according to matching symbols on a plurality of reels or video depiction of reels, the art is replete with examples of such devices that vend lottery tickets. (E.g., Heidel)

11. Applicant argues that Castellano and Dabrowski fail to teach counting coins until a ticket is generated. As noted above, this is not the case. Castellano teaches counting every coin put into the machine. Thus Castellano teaches counting coins until a ticket is generated.

12. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, it is extremely well known to have visual displays to show the number of coins inserted into any coin-operated machine. The art is littered with slot machines that show the number of coins inserted – as Applicant is no doubt aware. The reason for this is also well known – people like to know how many coins they have put into a slot machine and how many they have left to gamble. This, too, is common knowledge. Anyone with ordinary skill in the art would know these two facts (i.e., the knowledge is generally available to one of ordinary skill in the art). These facts provide a reason to combine the two references. Castellano teaches keeping track of the number of coins inserted (as all slot machines must in order to be licensed) and Dabrowski teaches displaying that number to the player – as one of ordinary skill would have known was desirable to the player.

13. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Castellano teaches that the device may be placed in any gaming machine as a retrofit. Dabrowski teaches placing the device in a slot machine as a retrofit. Heidel is a slot machine. Clearly, there is a suggestion in both Castellano and Dabrowski to place their devices in a slot machine.

14. In regard to claim 7, Applicant argues that the bonus be paid on a single game machine and Piechowiak teaches paying the bonus on a linked gaming machine. This is not

commensurate with the scope of the claims – claim 7 is silent concerning the networked status of the machine.

15. All other arguments are that the claim is allowable because claim 1 is allowable. See the discussion of paragraph 14 above.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reference Name	US Patent Number	Applicability
Dietz et al.	6,527,157	Slot machine issues lottery tickets
Chowdhury	6,623,357	Slot machine issues lottery tickets
Mattice et al.	6,702,667	Slot machine issues lottery tickets
Okuniewicz	6,858,589	Slot machine issues lottery tickets
Luciano et al.	6,685,559	Slot machine issues lottery tickets
Izawa et al.	6,264,556	Visible credit meter
LeStrange et al.	5,470,079	Visible credit meter
Brosnan et al.	6,682,423	Visible credit meter

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cbc

JESSICA HARRISON
PRIMARY EXAMINER